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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,356	09/11/2001	Matthias Witschel	49828	4151

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KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

ANDERSON, REBECCA L

ART UNIT PAPER NUMBER

1626

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,356

Applicant(s)

WITSCHER ET AL.

Examiner

Rebecca L Anderson

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2004 and 04 October 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-16,18-21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,9-11 and 13 is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6, 8, 12, 14-16 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1, 5-16, 18-21 and 23 are currently pending in the instant application.

Claims 1, 5, 6, 8, 12, 14-16 and 23 are rejected, claims 7, 9-11 and 13 appear allowable over the prior art of record and claims 18-21 are withdrawn from consideration as being for non-elected subject matter.

Election/Restrictions

In the amendment filed 4 October 2004, applicant has amended the claims to include only the elected group as identified in the office action mailed 31 December 2003. In the remarks filed 1 July 2004 applicant has continued to traverse the lack of unity requirement stating that the examiner has not given any reasons why applicants' intermediate compounds, defined in claims 18-21, and applicants' compounds of formula (I) lack unity of invention. However, as found in the lack of unity requirement and the office action mailed 31 December 2003, the technical feature involved in the claimed inventions is the tricyclic compound characterized in that the respective benzoyl unit is fused with a bicycle, which does not define a contribution over the prior art (as seen by WO 97/19087 and EP-A 860 441). The substituents on the tricyclic compound and the bicycle itself vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, the vastness of the claimed subject matter, and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter. Furthermore, even if unity of invention under

Art Unit: 1626

37 CFR 1.475(a) is not lacking, which it is, under 37 CFR 1.475(b) a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

And, according to 37 CFR 1.475(c)

if an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b), unity of invention might not be present.

The requirement is still deemed proper and is the FINALITY is maintained.

Response to Amendment and Arguments

Applicants amendment file 4 October 2004 amending claims 1, 5, 11 and 23 and canceling claims 2 and 4 has overcome the objection to claim 5 as containing minor informalities and the objection to claims 1-16 as containing non-elected subject matter. Applicant's arguments filed 1 July 2004 have been fully considered but they are not persuasive. Applicants' first argument and discussion is that the Examiner's position that Tseng's disclosure is generic to applicants' invention and is not deemed to be well taken. However, it is noted that the examiner did not take the position that Tseng's disclosure is generic to applicants' invention but that TSANG et al. I generically encompasses positional isomers of the instantly claimed compounds. Furthermore, on page 4 of applicants remarks, applicants' representative states that "all of the compounds within the generic disclosure of Tseng are at least positionally isomeric to

Art Unit: 1626

applicants' compounds...", which is what the examiner has stated in the previous office action. Applicants' second argument and discussion is that Tseng does not suggest or imply that any one of the various positional isomers of the disclosed compounds is useful and cannot be considered to motivate a person of ordinary skill in the art to select one specific positional isomer from the various positional isomers which are possible and to be a prima facie case of obviousness, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference; there must be a reasonable expectation of success; and the prior art reference must teach or suggest all the claim limitations. This argument is not found persuasive because TSANG et al. discloses the compound of formula I which generically encompasses positional isomers of the instantly claimed compounds and provides preferences towards positional isomers of the instantly claimed compounds and provides schemes 17 and 19 which disclose methods of preparation for these compounds which have the discloses use as herbicidal formulation. The motivation would be that it is expected that the further production of compounds similar in structure would have similar herbicidal properties, that the prior art provides preferences towards positional isomers of the instantly claimed compounds and that nothing unobvious is seen in substituting the known claimed isomer for the structurally similar isomer, as taught by TSANG et al., since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results. In re Norris, 84 USPQ 458 (1950).

Maintained Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, 12, 14-16 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/19087 (TSENG et al.).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

The invention of the instant application claims tricyclic benzoylpyrazole compounds of the formula I wherein X is a bond, Y together with the two carbons to which it is attached forms a saturated, partially saturated or unsaturated 1,2-oxazole ring and R9 is the radical IIa (claim 1) wherein R1 and R2 can be hydrogen, R3 can be C1-C6 alkyl, R4 can be C1-C6 alkyl, R5 can be hydrogen and I can be 0 or 1 (claim 5) and wherein R10 can be hydroxyl, R11 can be C1-C6 alkyl and R12 can be hydrogen (claim 6 and 23). The instant application also claims a herbicidal composition of the compound as found in claim 1 (claim 14), its method of preparation (claim 15) and a method for controlling undesirable vegetation with the compound as found in claim 1 (claim 16). Processes for the preparation of the compounds of formula I as found in

Art Unit: 1626

claim 1 by reaction with the compound of formula III wherein L1 is a nucleophilically replaceable leaving group are claimed in claim 8 and processes for the preparation of the compounds of formula I as found in claim 1 by reaction of a pyrazole of formula VII with an activated tricyclic benzoic acid of formula VI β are claimed in claim 12.

Determining the scope and contents of the prior art

TSANG et al. discloses the herbicidal active (page 141, lines 25-26) compounds of the formula I as found on page 1, line 20 wherein Q can be Q-2 (page 1, lines 20-25 and is also preferred to be Q-2 (page 12, line 20, preference 5), J is as found on page 2, lines 1-5, m is 0, 1 or 2, n is 1 or 2 and p is 0, 1, or 2 (page 4, lines 5-10). Preferences towards the compound wherein Y together with the two carbons to which it is attached forms an unsaturated 1,2-oxazole ring is found on page 7 (compound J-9) wherein R18 can be hydrogen, C1-C6 alkyl, C1-C6 haloalkyl, etc. (page 11). Preferences towards compounds wherein X is CH₂ is found on page 161 in the Index Table C (compound #25). Preferences towards compounds wherein R1 and R2 can be H and C1-C3 alkyl, etc., R7 is H or C1-C6 alkyl and R8 is hydrogen (page 12, preference 6). Preferences for R6, when Q is Q-2, as OR14 and OH is found on page 23, lines 14-22, scheme 17. Herbicidal formulations of the compounds and methods of preparing are found on page 139, lines 1-20 and page 165, Test A. Page 141 discloses the method for controlling undesirable vegetation, lines 25-40. Page 23 discloses scheme 17 which is a method for the preparation of compounds of the formula Ie, wherein Q is Q-2 by reaction with a compound of the formula 18 wherein X₂ is chlorine and R14 can be H, C1-C6 alkyl, C1-C6 haloalkyl, etc. (page 3, line 35). Page 24 discloses scheme 19 wherein a compound

Art Unit: 1626

f the formula 5, an activated tricyclid benzoid acid (page 16, lines 5-10) is reacted with the compound of formula 20, a pyrazole compound.

Ascertaining the differences between the prior art and the claims at issue

The difference between the prior art and the claims at issue is that the prior art generically encompasses and provides preferences towards positional isomers (i.e. the carbonyl moiety is in the para position in regards to X instead of the ortho position) of the instantly claimed compounds.

Resolving the level of ordinary skill in the pertinent art

However, minus a showing of unobvious results, it would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the instantly claimed compounds, with the instantly claimed methods of claims 8 and 12 for use as herbicidal formulations when faced with the prior art of TSANG et al. which discloses the compound of formula I which generically encompasses positional isomers of the instantly claimed compounds and provides preferences towards positional isomers of the instantly claimed compounds and provides schemes 17 and 19 which disclose methods of preparation for these compounds which have the discloses use as herbicidal formulation. The motivation would be that it is expected that the further production of compounds similar in structure would have similar herbicidal properties, that the prior art provides preferences towards positional isomers of the instantly claimed compounds and that nothing unobvious is seen in substituting the known claimed isomer for the structurally similar isomer, as taught by TSANG et al., since such structurally related compounds suggest one another and would be expected to share

Art Unit: 1626

common properties absent a showing of unexpected results. In re Norris, 84 USPQ 458 (1950).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rebecca Anderson
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

2/9/05



Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600